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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/097,035	06/12/1998	JAMES A. KROM	9608042	2485

7590 11/04/2004
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EXAMINER

REDDICK, MARIE L

ART UNIT PAPER NUMBER

1713

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/097,035

Applicant(s)

KROM ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/20/04;04/08/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10,13,14,21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10,13,14, 21 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under Ex Parte Quayle, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 01/20/04 has been entered.

Response to Amendment

2. Applicant's amendment filed on 01/20/04 has been fully considered with the following results. The Amendment is insufficient to remove the rejection based on Coran et al as per reasons set forth infra.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

4. Claims 2, 4, 6 & 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "A reaction product" per the preamble of claim 2 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited "A composition". It is suggested that applicant adopt the following language: "A composition according to claim 1, wherein said carboxylic acid or said anhydride of carboxylic acid is derived from maleic acid or maleic anhydride".

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B) The recited "amine terminated styrene-butadiene" per claim 23 constitutes indefinite subject matter as per it not being readily ascertainable if monomers of styrene and butadiene or intended or if a copolymer of styrene-butadiene is intended.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-10, 13 & 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Coran et al (U.S. 4,409,365).

Coran et al teach elastoplastic compositions defined basically as containing nitrile rubber, an amine terminated nitrile rubber, polypropylene, maleic acid modified polypropylene and other conventional additives such as curatives, stabilizers, and etc. and wherein, as a preferred embodiment, the amine-terminated nitrile rubber includes butadiene copolymers comprising as little as 20 wt. % of acrylonitrile which clearly translates to acrylonitrile rubbers with 80 wt. % of butadiene (col. 2, lines 49-68, col. 3, lines 1-8 & 15-35 and TABLE 1). In particular, Coran et al teach a composition comprising a block copolymer that comprises segments derived from an amine-terminated nitrile rubber and maleic acid polypropylene (Claim 8). Coran et al therefore anticipate the instantly claimed invention with the understanding that "consisting essentially of" limits the scope of a claim

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to the specified ingredients and those that do not materially affect the basic and novel characteristics of a composition (Ex parte Davis, 80 USPQ 448 and In re Janakirama-Rao, 317 F. 2d 951, 137 USPQ 893).

As to the dependent claims, the limitations, if not taught or suggested would have been obvious to the skilled artisan and with a reasonable expectation of success, i.e., any additional or particular claim parameters which may not be specifically set out in Coran et al are considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary.

Even if it turns out that the Examiner has somehow missed the boat and the claims are not anticipated, it would have been obvious to the skilled artisan to extrapolate, from Coran et al, the precisely defined composition, as claimed, as per such having been within the purview of the general disclosure of Coran et al and with a reasonable expectation of success.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

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matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4, 6-10, 13, 14, 21 & 23 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Liang et al (U.S. 5,705,564) or Hesp et al (U.S. 5,708,061).

Liang et al and Hesp et al teach stabilized polyolefin-modified bitumen compositions (Abstract). Specifically, Liang et al and Hesp et al teach compositions defined basically as containing an amine-terminated polydiene such as an amine-terminated polybutadiene, an amine-terminated poly(butadiene-co-acrylonitrile) and an amine-terminated poly(butadiene-co-styrene), a liquid polybutadiene, a carboxylated olefinic polymer such as carboxylated homo- and copolymers of ethylene & propylene and other conventional adjuvants (col. 4, lines 44-63, col. 5, lines 50-57, col. 7, lines 46-67, col. 8, lines 1-67, col. 9, lines 1-17 and the claims of Liang et al and col. 4, lines 16-21, col. 5, lines 29-67, col. 6, lines 1-65, col. 7, lines 25-40 and the claims, specifically claims 9, 13, 19 & 28-31 of Hesp et al). More specifically, Liang et al and Hesp et al exemplify compositions containing at least carboxylated polyethylene with an anhydride content of 0.07 g mole/kg of resin, liquid polybutadiene and liquid amine-terminated poly (butadiene-co-acrylonitrile), Run 3. Each of Liang et al and Hesp et al therefore anticipate the instantly claimed invention. One having ordinary skill in the art would have readily envisioned the use of amine-terminated polybutadiene or amine-terminated poly (butadiene-co-styrene) in lieu of the amine-terminated poly (butadiene-co-acrylonitrile) per Run 3, following the guidelines of Liang et al @ col. 4, lines 43-63 and Hesp et al @ col. 6, lines 9-26.

As to the dependent claims, the limitations, if not taught or suggested would have been obvious to the skilled artisan and with a reasonable expectation of success, i.e., any additional or particular claim parameters which may not be specifically set out in Liang et al and Hesp et al are considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary.

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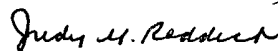
Even if it turns out that the Examiner has somehow missed the boat and the claims are not anticipated, it would have been obvious to the skilled artisan to extrapolate, from Liang et al and Hesp et al, the precisely defined composition, as claimed, as per such having been within the purview of the general disclosures of Liang et al and Hesp et al and with a reasonable expectation of success.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
10/28/04